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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
REID, CHERYL M	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/977,218	TANAKA, YOKO	
	Examiner	Art Unit	
	Cheryl M. Reid	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-9 and 11-22* is/are pending in the application.

4a) Of the above claim(s) *4 and 10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-9 and 11-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims *1-3,5-9 and 11-22* have been examined.

Priority

2. A certified copy of the foreign application to which Applicant claims benefit has not been received. Applicant is reminded that in order to receive the priority date of a foreign application a certified copy of the foreign application is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6, 13-17, and 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The system providing method claims fail to set forth the operation of the claimed elements as tangible embodied on an article of manufacture.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14 and 19 recites the limitation "the period". There is insufficient antecedent basis for this limitation in the claim. Proper correction is required.

Response to Arguments

5. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 7,5,11 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki et al (US 6644553) hereinafter Ohki, and further in view of Bornemann et al (US 6199752) hereinafter Bornemann.

8. In regards to claim 1, Ohki teaches of :

- checking justifiability of the first portable electronic device based on the data stored in the first portable electronic device when the directive data for the application downloading from the terminal device (Col 5, lines 15-20, Fig 19, Col 7, lines 1-25);
- demanding the setting of a portable electronic device to download the application data when the first portable electronic device is confirmed to be justifiable;

reading out application data desired by a holder from the memory when receiving data showing the completion of setting the first portable electronic device or a second portable electronic device differing from the first portable electronic device as a portable electronic device in which an application is downloaded; and transmitting the read application data to the terminal device by directing download of the application to the portable electronic device that is set as described above (col 6, lines 35-45).

- Ohki does not explicitly teach on the remaining limitations. Bornemann teaches of wherein the reading judging whether the set portable electronic device is the first portable electronic device or a second portable electronic device differing from the first portable electronic device when a data showing the setting completion of the portable electronic device to which an application is downloaded is received (Col 3, lines 20-25) and wherein the reading includes creating data relative to the individual data stored in the first portable electronic device and directing to store this relative data in the second portable electronic device when the set portable electronic device is judged to be the second portable electronic device in the judging step (Col 4, lines 1-10, 35-40); wherein when the set portable electronic device is judged to be the first portable electronic device in the judging step or when the data showing the completion of storage of relative data in the second portable electronic device is received, reading out application data desired by a holder from the memory (col 3, lines 45-50). It would have been obvious to one of ordinary skill in the arts at the time of

invention to incorporate the above teachings because the inventions are analogous art (i.e. using IC cards/ smart cards to provide various functionality). One of ordinary skill in the art at the time of invention would have been motivated for the reasons discussed by Bornemann (Col 3, lines 5-10).

9. In regards to claim 7, Ohki teaches of storing application data relative to the provision of services (Fig 7); means for receiving the direction for the application downloading from the terminal device and various data transmitted from the holder (col 6, lines 35-45); justifiability check means for checking justifiability of the first portable electronic device based on the data stored in the first portable electronic device received by the receiving means when the download direction is received by the receiving means(Col 5, lines 15-20, Fig 19, Col 7, lines 1-25);

- setting demand means for demanding the setting of a portable electronic device to download application data when the first electronic device is confirmed justifiable by the justifiability check means; means for reading application data desired by the holder from the storing means when data showing the completion of the setting of the first portable electronic device or the second electronic device differing from the first electronic device is received by the receiving means as a portable electronic device for downloading applications; and means for transmitting the application data read by the reading means by directing the download of the application for the set portable electronic device to the terminal device (col 6, lines 35-45). Ohki does not explicitly teach of the remaining limitations.

- Ohki does not explicitly teach on the remaining limitations. Bornemann teaches of wherein the reading judging whether the set portable electronic device is the first portable electronic device or a second portable electronic device differing from the first portable electronic device when a data showing the setting completion of the portable electronic device to which an application is downloaded is received (Col 3, lines 20-25) and wherein the reading includes creating data relative to the individual data stored in the first portable electronic device and directing to store this relative data in the second portable electronic device when the set portable electronic device is judged to be the second portable electronic device in the judging step (Col 4, lines 1-10, 35-40) and wherein the reading of an application desired by a holder from the memory is executed when the set portable electronic device is judged by the judging means to be the first portable electronic device or when the data showing the completion of the storage of relative data in the second portable electronic is received by the receiving means (col 3, lines 45-50). See claim 1 for motivation.

10. In regards to claim 5 and 11, Challener teaches of : demanding the provision of data including at least individual data....(Col 7, lines 38-55).

11. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki and, Bornemann and as applied to claim 1 and 7 above, and further in view of Narasimhan.

12. In regards to claims 2 and 8, Ohki does not explicitly teach of ... transmitting the read out application data in the unusable state; and changing the application downloaded in the portable electronic device from the unusable state to the usable state when the data showing the normal completion of the download is received after transmitting the application data. Narasimhan teaches on this aspect (Col 11, lines 10-35). Adding the above mentioned feature would result in a more secure system because the data can only be decoded by the system interface (i.e. rogue points would be unable to decipher the data). It is for this reason that one of ordinary skill in the art at the time of invention would have been motivated to make the above-mentioned modifications.

13. Claims 6 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki et al (US 6644553) hereinafter Ohki, and further in view of Bornemann et al (US 6199752) hereinafter Bornemann. as applied to claim 1 above, and further in view of Bahl et al (US 6834341).

14. In regards to claims 6 and 12, neither of the above references teaches on these aspect. Parmasad teaches of means for presenting desired service levels....(col 3, lines 30-35, Col 15, lines 60-67). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the teachings because the inventions are analogous arts. One of ordinary skill in the arts at the time of invention would have been motivated for the reasons discussed by Bahl (Col 2, lines 35-45).

15. Claim 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki, and further in view of Bornemann as applied to claim 1 above, and further in view of Chen (US 6442556).

16. In regards to claim 3, neither Ohki nor Bornemann teaches explicity of the limitations. Chen teaches of checking whether it is possible to download an application data desired by a holder relative to the memory capacity of the set first or second portable electronic device when the data showing the completion of the setting of the first portable electronic device or a second portable electronic device differing from the first portable electronic device is received as a portable electronic device to which the application is downloaded; demanding the setting of another portable electronic device for downloading an application data when the download is judged being not possible as a result of the above capacity checking; and reading the application data and transmitting the read application when the download is judged to be possible (Col 3, lines 5-15, lines 40-50, Col 4, lines 5-7). One of ordinary skill in the art at the time of invention would have been motivated for the reasons discussed by Chen (col 1, lines 22-25).

17. Claims 13, 16, 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki et al (US 6644553) hereinafter Ohki , and further in view of Challener et al (US 6081793) hereinafter Challener.

18. In regards to claim 13, Ohki teaches of : checking justifiability of the portable electronic device based on the data store in the portable electronic device when the download direction is received from the terminal device (Col 5, lines 15-20, Fig 19, Col 7, lines 1-25); but does not explicitly teach of the remaining limitations. Challener teaches of judging whether the holder has the right to vote from the data stored in the portable electronic device when the portable electronic device is confirmed to be justifiable (col 7, lines 40-50); reading the application data relative to the vote from the memory when the holder is judged to have the voting right; directing the terminal device to download the application to the portable electronic device and transmitting the read application data relative to the vote (col 8, lines 1-10); and accepting the accessed data relative to the vote using the portable electronic device with the application relative to the vote downloaded (col 8, line 10). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art (i.e. using IC cards/ smart cards to provide various functionality). One of ordinary skill in the art at the time of invention would have been motivated for the reasons discussed by Challener (Col 1, lines 40-50).

19. In regards to claims 16, Ohki teaches of checking justifiablilty of the portable electronid device....(col 5, lines 20-45) but doesn't expliclty teach of the remaining

limitations. Challener teaches of the remaining limiations (Col 7, lines 35-67, col 8, lines 1-15). See claim 13 for motivation.

20. In regards to claim 17, Challener teaches of directing an invalidation...(Col 7, lines 35-60). See claim 13 for motivation.

21. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki and Challener, and further in view of McClure et al (US 20010037234) hereinafter McClure.

22. In regards to claim 14, neither of the above references explicity teach of the limitations. McClure teaches of judging whether a date or time ....(Paragraph [0003,0067]).). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art. One of ordinary skill in the art at the time of invention would have been motivated for the reasons discussed by Challener (Col 1, lines 40-50).

23. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohki and Challener as applied to claim 13 above, and further in view of Bornemann.

24. In regards to claim 15, Ohki teaches of demanding the setting of a portable electronic device to which the application data (col 6, lines 35-45) but does not explicity teach of the data relative to voting and does not explicitly teach of remaining limitations.

Challener teaches of data relative to the vote is downloaded when the holder is judged to have the voting right wherein the application data relative to the vote is read from the memory (Col 8, lines 1-15) but does not explicitly teach of the remaining limitations. Bornemann teaches of judging whether the set portable set electronic device is the first portable electronic device or the second portable electronic device differing from the first portable electronic device when the information showing the setting completion of the portable electronic device to which the application is downloaded (col 3, lines 20-23); and creating data relative to the individual data stored in the first portable electronic device, transmitting this relative data and directing to store it in the second portable electronic device when the set portable electronic device is judged as being the second portable electronic device as a result of the judgment (col 4, lines 1-10, lines 35-40); and reading application data from memory when the set portable electronic device is judged as being the first portable electronic device as a result of the judging step or when the information of the completion of storage of the relative data in the second portable electronic device is received (col 3, lines 45-50). See claim 13 for motivation.

25. Claims 18, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Challener and further in view of Ohki.

26. In regards to claim 18, Challenger teaches of : means for storing application data relative to the vote to be provided (fig 1a); means for receiving the directive data of the

downloading of the application relative to the vote and the data stored in the portable electronic device by the terminal device (Col 8, lines 10-20); means for judging whether the holder of the portable electronic device has the right to vote from the data stored in the portable electronic device when the portable electronic device is confirmed to be justifiable by the checking means (col 7, lines 35-55) means for reading application data relative to the vote from the memory when the holder is judged to have the voting right by the voting right judging means; means for directing the terminal device to download the application to the portable electronic device and transmitting the application data relative to the vote that is read by the reading means; and means for accepting the data relative to the vote that is accessed using the portable electronic device to which the application relative to the vote is downloaded (Col 8, lines 1-15). Challenger does not explicitly teach of the remaining limitations. In an analogous art Ohki teaches of means for checking justifiability of the portable electronic device based on the data stored in the portable electronic device received by the when the directive data for the download is received by the receiving means(col 7, lines 1-20). See claim 13 for motivation.

27. In regards to claim 21, see discussion of claim 16.

28. In regards to claim 22, see discussion of claim 17.

29. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Challener and further in view of Ohki, and further in view of McClure et al (US 20010037234) hereinafter McClure.

30. In regards to claim 19, neither of the above references explicity teach of the limitations. McClure teaches of judging whether a date or time ....(Paragraph [0003,0067]).). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art. One of ordinary skill in the art at the time of invention would have been motivated for the reasons discussed by Challener (Col 1, lines 40-50).

31. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Challener and Ohki as applied to claim 18 above, and further in view of Bornemann.

32. In regards to claim 20, see the discussion of claim 15.

Conclusion

33. This action is NON-FINAL.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M. Reid whose telephone number is 571 272 3903. The examiner can normally be reached on Mon- Fri (7-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmr

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PRIMARY EXAMINER